



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/596,444 | 06/19/2000 | Wei Huang | LJL 354B | 4000 |

7590 07/05/2006

Kolisch Hartwell Dickinson McCormack & Heuser
James R Abney
520 S W Yamhill Street
Suite 200
Portland, OR 97204

EXAMINER

LAM, ANN Y

ART UNIT PAPER NUMBER

1641

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 09/596,444 | Applicant(s) HUANG ET AL. | |
| | Examiner Ann Y. Lam | Art Unit 1641 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-59 and 61-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-59 and 61-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 50-52, 54, 55, 57, 59 and 62-65 are rejected under 35 U.S.C.

103(a) as being unpatentable over Nikiforov, 6,287,774, in view of Zhou et al. "Detection and Sequencing of Phosphopeptides Affinity Bound to Immobilized Metal Ion Beads by Matrix-Assisted Laser Desorption/Ionization Mass Spectrometry", American Society for Mass Spectrometry, April 2000, Vol. 11, pp. 273-282.

Nikiforov discloses the invention substantially as claimed.

As to claim 50, Nikiforov discloses a method of detecting addition or removal of a phosphate group to or from a substrate (col. 13, lines 40-42, and lines 47-50), comprising:

contacting a luminescent peptide (i.e., fluorescently labeled phosphorylatable substrate 302, col. 13, line 20) with a binding partner (i.e., polycation, col. 13, line 26) that binds specifically to the peptide only if the peptide is phosphorylated (col. 13, lines 29-30), wherein the binding partner includes an entrapped metal (col. 13, line 35) that selectively binds to phosphorylated peptides, and wherein the peptide is a substrate (302, col. 13, line 20) for an enzyme (i.e., kinase enzyme 306, col. 13, line 20) that

Art Unit: 1641

catalyzes addition or cleavage of a phosphate group to or from a protein (col. 13, lines 19-21),

and measuring luminescence polarization from the luminescent peptide (col. 6, lines 1-5), wherein the amount of measured luminescence polarization can be related to the extent of binding between the luminescent peptide and the binding partner (col. 6, lines 1-12.)

However, Nikiforov does not list gallium as an example of the entrapped metal. (Rather Nikiforov teaches that the entrapped metal is a multivalent metal cation that may for example be Fe^{3+} (see col. 13, lines 32-39.)

Zhou et al. however teach the motivation to use gallium as the metal ion. Zhou et al. teach that immobilized metal ions, such as Fe^{3+} bind with high specificity to phosphoproteins and peptides, and that Ga^{3+} (i.e., a gallium cation) has been discovered as having better selectivity for the phosphopeptides (page 274, left column, last paragraph).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a gallium cation as taught by Zhou et al. as the entrapped metal in the Nikiforov invention because Zhou et al. teaches that gallium has an advantage over other cations such as Fe^{3+} because it has better selectivity for phosphopeptides, which would result in more accurate results in the Nikiforov invention. (The Office also notes that both Nikiforov and Zhou et al. lists Fe^{3+} as an example of a metal cation that bind to phosphopeptides (see Nikiforov, col. 13, lines 35-42, and Zhou et al. page 274, left column, last paragraph) and that Zhou et al. further lists Ga^{3+} .

Thus, at the very least, Zhou et al. teach that Fe^{3+} and Ga^{3+} are functional equivalents as metal cations that bind to phosphoproteins.)

As to the following claims, Nikiforov discloses the limitations as follow.

As to claim 51, the step of correlating the measured luminescence polarization with kinase activity is disclosed (col. 6, lines 1-12, and col. 7, lines 27-31, and col. 13, lines 19-26.)

As to claim 52, phosphatase activity is determined (col. 13, lines 59-66).)

As to claim 54, the step of measuring luminescence polarization includes illuminating the sample with polarized light (col. 5, line 13.)

As to claim 55, the luminescent peptide is exposed to the enzyme in a reaction mixture to catalyze phosphorylation or dephosphorylation of the peptide (col. 13, line 19-21).

As to claim 57, the binding partner binds specifically to a phosphorylated protein substantially without regard to the particular amino acid sequence of the protein (col. 13, lines 29-31.)

As to claim 59, the method includes contacting the luminescent peptide and the enzyme with a candidate modulator (phosphate 304, col. 13, line 21), prior to the step of measuring luminescence polarization (col. 13, lines 19-21, and lines 38-46.)

As to claim 62, the step of exposing [the peptide to the enzyme] precedes the step of contacting [the peptide to the binding partner/metal cation], (col. 13, lines 19-21 and lines 25-26.)

As to claim 63, the step of exposing catalyzes a reaction having an end point, and wherein the step of measuring is performed at different times during the reaction before the end point (see col. 24, lines 56-67.)

As to claim 64, the step of exposing catalyzes a reaction having an end point, and wherein the step of measuring is performed at different times during the reaction before the end point (see col. 24, lines 56-67.)

As to claim 65, the step of measuring is performed after the step of contacting without separation of bound and unbound species of the luminescent peptide (col. 13, lines 25-26, lines 44-46, and col. 24, lines 26-56.)

2. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nikiforov, 6,287,774, in view of Zhou et al. "Detection and Sequencing of Phosphopeptides Affinity Bound to Immobilized Metal Ion Beads by Matrix-Assisted Laser Desorption/Ionization Mass Spectrometry", American Society for Mass Spectrometry, April 2000, Vol. 11, pp. 273-282, as applied to claims 50 and 55 above, and further in view of de Sauvage et al., 6,022,708.

Nikiforov in view of Zhou et al. disclose the invention substantially as claimed (see above), except for the assay being a competitive assay, including the step of catalyzing formation of unlabelled phosphorylated protein in the reaction mixture to competitively bind to the binding partner.

De Sauvage however teaches the motivation to perform the Nikiforov direct assay format in a competitive assay format.

De Sauvage discloses a method of detecting addition or removal of a phosphate group to or from a substrate (column 32, lines 56-58), comprising contacting a luminescent peptide (i.e., the "substrate", column 32, line 58) with a binding partner (i.e., "antibody", column 33, line 11) that binds specifically to the peptide only if the peptide is phosphorylated (column 33, lines 11-12), or only if the peptide is not phosphorylated, wherein the peptide is a substrate (i.e., "kinase substrate", column 32, line 53) for an enzyme that catalyzes addition or cleavage of a phosphate group to or from a protein (column 32, lines 53-55.)

De Sauvage discloses that various diagnostic assay techniques known in the art may be used, such as competitive binding assay, direct and indirect sandwich assays (column 28, lines 63-64.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize competitive binding assay as taught by de Sauvage in the Nikiforov assay method because de Sauvage teaches that competitive assays are an obvious alternative to the direct assay of Nikiforov to detect addition or removal of phosphate groups from a substrate.

3. Claims 53, 58 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nikiforov, 6,287,774, in view of Zhou et al. "Detection and Sequencing of Phosphopeptides Affinity Bound to Immobilized Metal Ion Beads by Matrix-Assisted Laser Desorption/Ionization Mass Spectrometry", American Society for

Art Unit: 1641

Mass Spectrometry, April 2000, Vol. 11, pp. 273-282, and applied to claim 50 above, and further in view of in view of Fuller, 5,424,190.

Nikiforov in view of Zhou et al. disclose the invention substantially as claimed (see above). Moreover, Nikiforov discloses examples of binding pairs substrates and enzymes (col. 7, lines 19-31.) However, Nikiforov does not disclose a stop solution including a chelator, and that the steps of contacting and measuring are performed in a microplate well.

Fuller teaches a stop solution such as EDTA which comprises a chelator useful to inactivate enzymes prior to analysis of the product of the enzymatic reagents (col. 1, lines 13-15 and 24-40, and col. 2, line 18, and lines 30-34.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide EDTA as a stop solution as taught by Fuller in the Nikiforov enzymatic assay method because Fuller teaches that such solution is conventionally used to inactive enzymes desirable for stopping a reaction in an enzymatic assay providing the advantage of facilitating subsequent analysis of the product of the enzymatic reagents in the Nikiforov assay.

Fuller also teaches use of a microtiter plate (which are known to have wells) for performing the assay reactions (col. 2, lines 36-38.)

It would have been obvious to utilize a microplate well as taught by Fuller in the Nikiforov assay method as a well known and conventional means to hold reagent and stop solutions as would be desirable for performing an assay.

4. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nikiforov, 6,287,774, in view of Zhou et al. "Detection and Sequencing of Phosphopeptides Affinity Bound to Immobilized Metal Ion Beads by Matrix-Assisted Laser Desorption/Ionization Mass Spectrometry", American Society for Mass Spectrometry, April 2000, Vol. 11, pp. 273-282, and applied to claims 50, 55 and 59 above, and further in view of Maxfield Wilson et al., 5,776,487.

Nikiforov in view of Zhou et al. disclose the invention substantially as claimed (see above), except for the particular order of carrying out the steps as recited in claim 61. That is, Nikiforov and Zhou et al. do not teach that the step of contacting the enzyme with the candidate modulator (phosphate) is performed before the step of exposing the luminescent peptide to the enzyme. (Rather, Nikiforov only discloses that the peptide (substrate) is contacted with the enzyme in the presence of the phosphate (304) and does not disclose any particular order.)

Maxfield Wilson et al. however teaches adding reagents in an assay simultaneously or sequentially for binding of the reagents (col. 5, lines 39-45.) It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Nikiforov reagents sequentially, such as contacting the enzyme with the phosphate before contacting the enzyme with the luminescent peptide because Maxfield Wilson et al. teach that simultaneously or sequentially contacting reagents equally provide the function of allowing binding between the reagents, such as the Nikiforov reagents.

Response to Arguments

Applicant's arguments and affidavit regarding the above rejected claims have been considered but are not persuasive.

Applicant argues on page 5 of Applicant's response that the cited references teach away from the claimed invention and that the claimed invention provides unexpected results.

More specifically Applicant argues on page 7 that the "better selectivity" of gallium as disclosed by Zhou et al., and as noted by Examiner, does not mean better binding, as would be pertinent to a binding assay, but rather a better combined ability to engage and release for subsequent use in mass spectrometry analysis. Applicant notes that the invention of Zhou et al. relates to detection of phosphopeptides that affinity bound to beads via immobilized metal ions and that the phosphopeptides are detected by matrix-assisted laser desorption/ionization mass spectrometry. Applicant states that Zhou et al. do not disclose any direct measure of binding alone. Applicant further notes that Zhou et al. concludes that gallium has better overall "selectivity" for the mass spectrometry assay being used, but however, with regard to binding itself, Zhou et al. suggest that iron binds phosphopeptides with higher affinity than gallium. Applicant's arguments are not persuasive because while Zhou et al. teach that iron binds phosphopeptides with higher affinity than gallium, Zhou et al. however teach that gallium has better selectivity and this teaching provides the motivation to use gallium. The better selectivity relates to binding. Zhou et al. specifically states that iron and aluminum bind with high specificity to phosphoproteins and peptides and that gallium

has been found to have better selectivity for the phosphopeptides. Zhou et al. then states that by selective isolation of phosphopeptides using metal ion affinity media before mass spectrometry, suppression effects can be greatly reduced (see page 274, left column, last partial paragraph.) Thus it is clear in Zhou et al. that "better selectivity" refers to high specificity of gallium for phosphopeptides. This advantage is relied upon by the Office as the teaching of the motivation to utilize gallium as the metal in the Nikiforov invention. As to Applicant's statement that Zhou et al. teach that iron binds phosphopeptides with higher affinity than gallium, that argument is also not persuasive for the following reasons. Applicant is referring to the disclosure of Zhou et al. on page 280. On page 280, Zhou et al. teach although both iron and gallium have high specificity for phosphopeptides, gallium binds more weakly with multiphosphorylated peptide than iron (page 280, first paragraph). However this teaching would not teach away from using gallium in the Nikiforov invention because the Zhou et al. teaching at issue refers to weak binding with multiphosphorylated peptides and the Nikiforov invention is not limited to multiphosphorylated peptides. In any case, the teaching of gallium having high specificity for phosphopeptides is the advantage that provides the motivation to utilize gallium in the Nikiforov invention.

Applicant also asserts on page 9 in the response with support in an affidavit that three significant unexpected benefits have been found using gallium in luminescence polarization assays that are neither taught nor suggested by the prior art. More specifically, Applicant asserts on pages 9 through 12 that the assay performed by Applicants show that the intensity was about one hundred fold higher in assays of the

Art Unit: 1641

product performed with gallium reagent relative to assays of the product performed with the iron reagent, in contrast to the iron reagent, which quenched luminescence intensity. Applicant states on pages 12 through 13 that the gallium reagent not only did not quench but actually enhanced intensity, and that this translates into dramatic differences in the timing and sensitivity of assays performed with these reagents and that these advantages are not obvious because metals are well-known luminescence quenchers (i.e., extinguishers). Applicant also asserts on page 14 that gallium-based polarization assays have significantly higher dynamic ranges than iron-based polarization assays, enhancing the speed at which assays can be performed. Applicant moreover maintains on page 15 that gallium-based polarization assays may be significantly more capable of detecting binding in assays involving mixtures of substrate and product than iron-based polarization assays. Applicant also supports these arguments in an affidavit regarding the performance and results of the above mentioned assays. These arguments however are not persuasive because Nikiforov teach that the metal in general is a multivalent metal cation that may for example be Fe^{3+} (see col. 13, lines 32-39.) Zhou et al. specifically teaches gallium, i.e., Ga^{3+} , which is a multivalent metal cation and that Ga^{3+} has better selectivity for the phosphopeptides than iron (page 274, left column, last paragraph), which provides the motivation to use Ga^{3+} in the Nikiforov invention as it would facilitate the detection of phosphorylated peptides because of its better selectivity for phosphorylated peptides, which would result in more accurate results. Based on the teachings of Zhou et al., it would be expected that Ga^{3+} would more readily facilitate the assay and provide more sensitive or clearer results

Art Unit: 1641

than using iron, Fe^{3+} , as would be indicated by higher intensity, because Zhou et al. teach that Ga^{3+} has better selectivity for the phosphopeptides than Fe^{3+} .

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is 571-272-0822. The examiner can normally be reached on Mon.-Fri. 10-6:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1641

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.L.

 6/23/06


LONG V. LE 05/24/06
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600